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TRANSMITTAL LETTER AND AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

RE: Attorney Docket No.:DEATON-18-USC1
Application No.:08/935,116
Filed: 9/22/97
Inventor: DEATON et al.
Group Art Unit:3622
Examiner:ALVAREZ, Raquel
Title: System, Method and Database for Processing Transactions

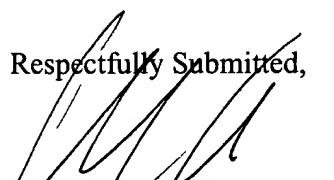
SIR:

Attached hereto for filing are the following papers:
37 CFR 1.181 Petition to Have a Requirement to Elect Withdrawn and to Have Withdrawn Claims Reinstated (4 Pages)

Our check in the amount of \$130.00 is attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet is enclosed.

5/19/2005
DATE

Respectfully Submitted,

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

Printed: April 11, 2005 (2:55pm)

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NEIFELD REF.: DEATON-18-USC1

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: DEATON ET AL.

USPTO CONFIRMATION CODE: 8230

SERIAL NO: 08/935,116

FILED: 9/22/1997

EXAMINER: ALVAREZ, Raquel

GROUP ART UNIT: 3622

FOR: System, method and Database for Processing Transactions

37 CFR 1.181PETITION TO HAVE A REQUIREMENT TO ELECT

WITHDRAWN AND TO HAVE WITHDRAWN CLAIMS

REINSTATED

05/20/2005 HALI11 00000074 08935116

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130.00 DP

I. Statement of the Relief Requested

The applicant requests that the Director instruct the examiner to withdraw the requirement to elect imposed in the office action mailed 5/13/2005, and to reinstate any claims withdrawn as a result of the applicant's response to that requirement.

II. Statement of Material Facts

On 9/22/1997, the applicants filed this application.

On or about 2000, judgement in an interference was entered in favor of this application.

On December 9, 2004, the BPAI mailed a decision on an appeal in this application inter alia reversing all rejections of claims 8-16 and not reversing all rejections of claims 17-39.

On 5/13/2005, the USPTO mailed an office action containing a requirement to elect (restriction requirement) between claims 8-16 and 17-39.

On or about 5/17/2005, the applicant filed an election with traverse, stating the following:

37 CFR 1.142. RESPONSE TO OFFICE ACTION CONTAINING A REQUIREMENT TO ELECT

In response to the requirement to elect between claims 8-16 and 17-76, the applicant elects claims 8-16, with traverse for four reasons.

First, the examiner's requirement to elect violates 37 CFR 1.142(a); this application is long after final, and after a decision on appeal on claims 8-39. 37 CFR 1.142(a) precludes a requirement to elect after final. Accordingly, the examiner's requirement to elect is improper and must be withdrawn.

Second, the examiner's requirement to elect is also improper given the long pendency of this applications and its claims. The examiner should be equitably estopped from requiring election because that will result in loss of

significant patent term, on the order of 5 years, due to the tardiness of the requirement.

Third, the examiner's requirement lacks merit. The examiner admits that both sets of claims are classified in class 705, subclass 26 showing no basis for any burden in search on the examiner. A showing of burden, in addition to an actual burden, are prerequisites for a sustainable requirement to elect. See section III.C.6 in "Continuation Applications, RCEs, Appeals, Petitions, Interferences, Public Use Proceedings, Determinations, and Oppositions Neifeld, published in Proceedings of "Practical Patent Prosecution Training for New Lawyers," (AIPLA 2004)." The examiner provides no such showing.

Fourth, the assertions of fact in support of the examiner's sole rationale in support of the requirement to elect are incorrect. The examiner states that allegedly distinct inventions I and II are related as sub combination of one another, *and distinct because* "invention II has the separate utility such as associating a customer number with a dollar amount."

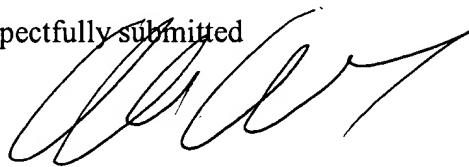
The foregoing quoted assertion is incorrect. Alleged Invention II is not a *sub combination* of invention I with respect to customer number and dollar amount. It is instead a *species* thereof, because the associating dollar amount with customer identification of alleged invention II is covered by, and a subset of, alleged invention II's "information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion" associated with the customer identification of group I. Thus, the utility of associating a dollar amount with a customer number is generic to the allegedly distinct Invention I. In other words, the subject matter upon which the examiner allegedly distinct invention I and II are distinct, is common to both allegedly distinct inventions. Therefore, the inventions cannot be distinct in the manner asserted by the examiner.

For all of the foregoing reasons, the requirement is improper and should be withdrawn.

III. Reasons Why the Relief Requested Should be Granted

For the 4 reasons stated above, the requirement was improper and the relief requested is justified. Accordingly, this petition should be granted.

Respectfully submitted



Richard A. Neifeld

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Attorney of record

Printed: May 16, 2005 (7:46pm)

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